



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,589	03/10/2004	Matthew D. Nordstrom	005127.00288	4718
22910 7590 07/19/2011 BANNER & WITCOFF, LTD. 28 STATE STREET SUITE 1800 BOSTON, MA 02109-1701				
EXAMINER				
WORRELL JR, LARRY D				
ART UNIT		PAPER NUMBER		
3765				
MAIL DATE		DELIVERY MODE		
07/19/2011		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/797,589

Applicant(s)

NORDSTROM, MATTHEW D.

Examiner

DANNY WORRELL

Art Unit

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-895)
Paper No(s) Mail Date ____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s) Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

Receipt is acknowledged of a request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e) and a submission, filed on 6/1/11. The RCE submission, however, is improper since applicant cannot request continued examination of an application until after prosecution in the application is closed. See 37 CFR 1.114(a). Prosecution in an application is closed if the application is under appeal, or the last Office action is a final action (37 CFR 1.113), a notice of allowance (37 CFR 1.311), or an action that otherwise closes prosecution in the application (e.g., an Office action under Ex parte Quayle, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935).

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The subject matter “an exterior surface that is substantially parallel to the interior surface and is completely exposed to an exterior of the swimsuit body” is not provided in the specification.

Claim Rejections - 35 USC § 112

Claims 1-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "substantially parallel" in claims 1 and 21 is a relative term which renders the claim indefinite. The term "substantially parallel" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 7-11, 15, 19, 21, 22, 26-29 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Doerschuk et al (US 4365351).

The disclosure of Doerschuk et al (US 4365351) teaches the invention as claimed including an article of swimwear comprising, in combination: a swimsuit body (10) having at least one aperture (neck and arms) configured to encircle a portion of a swimmer's body when the swimsuit body is worn by a user; a resilient seal (20, 22) having an interior surface, first portion of the interior surface secured about the at least one aperture on an exterior of the swimsuit body and a second portion of the interior surface extending beyond the swimsuit body and configured to contact the user's body when the swimsuit body is worn by the user. Note an adhesive in the form of tape (42) is used to secure the seal. Concerning the recitation "configured to be stretched over a swimmer's body so as to provide a conforming fit on a swimmers body",

as broadly recited the swimsuit body of Doerschuk is *stretched* over a swimmer's body to provide a conforming fit on a swimmer's body to as seen at least in the chest covering portion of figure 2 and the waist covering portion of figure 5. The term "stretch" reasonably encompasses extending, spreading, or placing something. Concerning the additional language of "such that the entire swimsuit body provides a conforming fit", the entire swimsuit of Doerschuk does provide a *conforming* fit given the bendable, flexible, pliable nature of the swimsuit body. The term "conforming" reasonably includes the act of making similar in form, nature, character or bringing into agreement, correspondence, or harmony. Undoubtedly the entire swimsuit of Doerschuk provides such a conforming fit. Concerning the recitation, "and an exterior surface that is substantially parallel to the interior surface and is completely exposed to an exterior of the swimsuit body", as is evidently seen in figure 2 of Doerschuk's alternate seal mounting structure, the seal has an exterior surface that is "substantially parallel" to the interior surface and is completely exposed to an exterior of the swimsuit body.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 6, 9-11, 13, 19-25, 28, 29, 31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman (6088832) in view of Doerschuk et al (US 4365351). Newman (6088832) teaches the invention as claimed including an article of swimwear comprising, in combination: a swimsuit body (10) having at least one aperture (24-27)

configured to encircle a portion of a swimmer's body when the swimsuit body is worn by a user; a resilient seal (31) having a first portion (back face 33) secured about the at least one aperture and a second portion (front face 32) extending beyond the swimsuit body and configured to contact the user's body when the swimsuit body is worn by the user. Note that the strip is attached by adhesion or stitching. Note that the seal encircles waist and legs. However, the seal of Newman is set forth on an interior of the swimsuit body rather on an exterior of the swimsuit body. The disclosure of Doerschuk et al (US 4365351) shows an alternative mounting system for mounting resilient seals on an exterior of a swimsuit. It would have been obvious at the time the invention was made to provide the mounting of the seal of Newman as an exterior mount as shown by Doerschuk et al (US 4,365,351) since such is a well known alternative mounting structure and in order to have unfettered access to the seal while the suit is being worn so that the seal can be visually inspected for wear and/or replaced. Concerning the recitation "configured to be stretched over a swimmer's body so as to provide a conforming fit on a swimmers body", as broadly recited the swimsuit body of Newman is *stretched* over a swimmer's body to provide a *conforming fit on a swimmer's body*. The term "stretch" reasonably encompasses extending, spreading, or placing something. Concerning the additional language of "such that the entire swimsuit body provides a conforming fit", the entire swimsuit of Newman does provide a *conforming* fit given the bendable, flexible, pliable nature of the swimsuit body. The term "conforming" reasonably includes the act of making similar in form, nature, character or bringing into agreement, correspondence, or harmony. Undoubtedly the entire swimsuit of Newman provides such a conforming fit as broadly recited. Concerning the recitation, "and an exterior surface that is substantially parallel to the interior surface and is completely exposed to

an exterior of the swimsuit body”, as is evidently seen in figure 2 of Doerschuk’s alternate seal mounting structure, the seal has an exterior surface that is “substantially parallel” to the interior surface and is completely exposed to an exterior of the swimsuit body.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 7, 8, 12, 14-18, 26, 27, 30, 32 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman (6088832) in view of Doerschuk et al (US 4365351).

The combined disclosures of Newman and Doerschuk et al (US 4365351) teach the invention as claimed as set forth above in the rejection to claim 1. They do not teach welding for securing the seal to the swimsuit. The examiner takes Official Notice that it is well known to secure garment elements via welding. Therefore it would have been at the time the invention was made to substitute welding for stitching or adhesive for securing the seal to the garment since any of these would provide an equivalent securing function. Concerning the specific location of the seal as encircling the arm and neck of the user, it would have been obvious to provide the seal at both a neck portion and arm portion in order to prevent water from entering the swimsuit at such locations. Concerning the specific swimwear style of extending to the ankles, it would

have been obvious to provide choose from a number of different swimwear styles including those which extend to the ankles in order to find the style which covers various portions of a users body as required for a specific swimming activity.

Response to Arguments

Applicant's arguments with respect to claims 1-36 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANNY WORRELL whose telephone number is (571)272-4997. The examiner can normally be reached on MONDAY and WEDNESDAY-FRIDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, GARY WELCH can be reached on 571/272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DANNY WORRELL/
Primary Examiner, Art Unit 3765

ldw